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PATENT APPLICATION
Attorney Docket No. 99477-US-NP

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Application of: Carl H. Hauser

Art Unit: 2154

Serial No.: 09/472,762

Examiner: Kenny S. Lin

Filed: 12/27/1999

Confirmation No: 9175

Title: PERSONAL DOCUMENT MANAGEMENT SYSTEM

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Carl H. Hauser

Group Art Unit: 2154

Application No.: 09/472,762

Examiner: Kenny S. Lin

Filed: December 27, 1999

Confirmation No.: 9175

For: PERSONAL DOCUMENT MANAGEMENT SYSTEM

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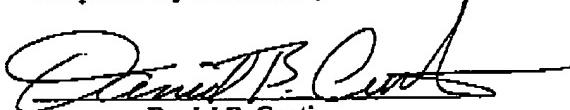
Sir:

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES****LETTER**

Enclosed herewith is an original Appellants' Brief on Appeal in the above-identified application. An oral hearing is not requested.

Please charge the fee for filing of the Appeal Brief to Xerox Corporation, Deposit Account No. 24-0025.

Respectfully submitted,



Daniel B. Curtis

Signature under 37 CFR 1.33 & 34

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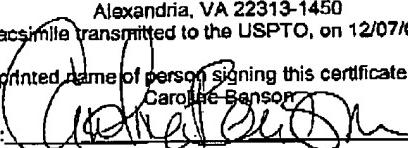
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

1st Named Inventor: Carl H. Hauser

Assignee: XEROX Corporation

Title: PERSONAL DOCUMENT MANAGEMENT SYSTEM

Serial No.: 09/472,762 Filed: 12/27/1999

Examiner: Lin, Kenny S. Art Unit: 2154

Docket: 99477-US-NP Confirmation: 9175

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APPEAL BRIEF

Sir:

Applicant submits this Appeal Brief to the Board of Patent Appeals and Interferences in support of an appeal from the rejections in the Final Office Action dated June 9, 2005 in the above-referenced patent application.

Application No. 09/472,762
Technology Center 2100 – Art Unit 2154

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REAL PARTY IN INTEREST

The real party in interest in the subject application is Xerox Corporation, the assignee of record.

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RELATED APPEALS AND INTERFERENCES

The undersigned and the assignee are not aware of any related appeals, interferences or judicial proceedings (past or present) which will directly affect, or be directly affected by, or have a bearing on, the Board's decision in this appeal.

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STATUS OF CLAIMS

Claims 1 - 18 are pending in this application, of which claims 1, 3, 5 and 7 are independent claims. Claims 1 – 18 stand rejected. The Claims Appendix, following the Argument, provides the text of the appealed claims.

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STATUS OF AMENDMENTS

Appellant has filed no amendments in the subject application subsequent to the Final Office Action mailed on June 9, 2005.

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SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 and dependent claims 2 – 3 and 9 – 12 are directed to a computer-implemented method for adding a document to a plurality of stored documents. The flowchart of Figure 2 illustrates an example of steps that may be performed in the method. The method begins with loading the document into storage (Specification, page 4, lines 19 – 23; Fig. 2, box 204.) The loaded document may include document format data specifying whether the loaded document is an electronic document or a document image. (Dependent claim 9; page 4, lines 20 – 23 to page 5, lines 1 -2.) A document category associated with the document is then determined. (Page 5, lines 10 – 23 to page 6, lines 1 – 4; Fig. 2, box 206.) In one implementation, the document category of the loaded document is determined by data content extracted from the loaded document and matched to a pre-determined set of document categories (dependent claim 10; page 5, lines 2 – 9). In another implementation, the document category is determined by a pre-determined category input with the loaded document (dependent claim 11; page 5, lines 19 – 23).

Information is then extracted from the loaded document indicating at least one of a document date, a document transaction type and a document identifier. (Page 7, lines 13 – 23 to page 6, lines 1 -4; Fig. 2, box 216.) The method of claim 1 then includes applying at least one document handling procedure associated with the document category of the loaded document to the loaded document. (Page 6, lines 15 – 23 to page 7, lines 1 -12; Fig. 2, box 210.) The document handling procedure links the loaded document to at least one of the plurality of stored documents using the at least one of the document date, the document transaction type and the document identifier extracted from the loaded document. (Page 8, lines 5 -6; Fig. 2, box 218.) The document handling procedure may include retention criteria for determining how long to save the loaded document. (Dependent claim 2; page 8, lines 7 – 23.)

In a particular embodiment, the information extracted from the loaded document is a document identifier indicating an account number and a transaction date, and the document handling procedure links the loaded document to a set of stored documents having the same account number and orders the loaded document among the set of stored

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documents by the transaction date. (Dependent claim 12; page 6, lines 15 – 23 to page 7, lines 1 – 7.)

Independent claim 3 and dependent claims 4 and 13 – 15 are directed to a computer system having a processor, a display and memory, the memory including an operating environment, and a computer-readable medium having computer-executable instructions for performing a method for adding a document to a plurality of stored documents. The method referred to in claim 3 proceeds as described above with respect to claim 1. Dependent claims 4 and 13 – 15 recite the same limitations found in dependent claims 2 and 9 – 12 as described above.

Independent claim 5 and dependent claims 6 and 16 – 18 are directed to a computer program product having a computer-readable medium holding computer-executable instructions for performing a method for adding a document to a plurality of stored documents. The method referred to in claim 5 proceeds as described above with respect to claim 1. Dependent claims 6 and 16 – 18 recite the same limitations found in dependent claims 2 and 9 – 12 as described above.

Independent claim 7 and dependent claim 8 are directed to a method for transferring a computer program product from one or more first computers to a second computer connected to the one or more first computers through a communications medium, the computer program product including computer-executable instructions for adding a document to a plurality of stored documents. The computer-executable instructions referred to in claim 7 cause actions to take place as described above with respect to claim 1. Dependent claim 8 recites the same limitations found in dependent claim 2 as described above.

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GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- I. Whether claims 1, 3, 5, 9 – 10, 13 and 16 are anticipated under 35 U.S.C. § 102(b) by the disclosure of U.S. Patent 5,721,910 issued to Unger et al.
- II. Whether claims 7, 11, 14 and 17 are patentable under 35 U.S.C. § 103(a) over the disclosure of U.S. Patent 5,721,910 issued to Unger et al. in view of Official Notice.
- III. Whether claims 2, 4, 6 and 8 are patentable under 35 U.S.C. § 103(a) over the disclosure of U.S. Patent 5,721,910 issued to Unger et al. in view of the disclosure of U.S. Patent 5,071,419 issued to MacPhail.
- IV. Whether claims 12, 15 and 18 are patentable under 35 U.S.C. § 103(a) over the disclosure of U.S. Patent 5,721,910 issued to Unger et al. in view of the disclosure of U.S. Patent 6,418,457 issued to Schmidt et al.

The Final Office Action (dated 6/09/05) also included a rejection of independent claim 7 under 35 U.S.C. § 112 because the term “personal documents” in line 14 (referenced as line 16 in the Final Office Action) of the claim lacks proper antecedent basis. Appellant is not appealing this rejection. In a Reply to a previous Office Action submitted in January 2005, appellant amended all of the claims to replace the term “personal document” with “stored document.” Appellant intended to make the same change to all occurrences of “personal document” in claim 7 but inadvertently overlooked the term “personal document” in line 14 and the change was not made. If the decision of this appeal results in allowable subject matter or further prosecution on the merits, claim 7 will be corrected to replace the term “personal documents” with “stored documents.”

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ARGUMENT

- I. The Final Office Action fails to state a *prima facie* case of anticipation under 35 U.S.C. § 102(b) with respect to claims 1, 3, 5, 9 – 10, 13 and 16.

The Final Office Action rejected claims 1, 3, 5, 9 – 10, 13 and 16 under 35 U.S.C. § 102(b) as being anticipated by the disclosure of U.S. Patent 5,721,910 issued to Unger et al. (hereafter “Unger.”). The discussion that follows presents arguments with respect to the patentability of independent method claim 1. Since these arguments apply equally to the computer system of independent claim 3 and the computer program product of independent claim 5, claims 3 and 5 are not separately discussed.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In brief, the discussion will show that the Office Action of June 9, 2005 fails to show that the Unger reference teaches the element of applying a document handling procedure including all of the limitations recited in claim 1. Therefore, the Examiner has not made a *prima facie* case for a rejection under 35 USC § 102(b) based on the Unger reference because Unger does not teach each and every claim limitation of claims 1, 3 and 5 as arranged in those claims.

The Unger reference teaches the “determining the document category” element of claim 1 through the use of “expert technical searches.”

The database techniques disclosed in the Unger reference start with the creation of a hierarchical model of a complex business, scientific or technical entity or specialty (col. 2, lines 58 – 60), which Unger refers to as the Customized Technical Subject Hierarchy and describes as being part of “Stage IV” of Figure 1. (See col. 5, lines 16 – 17 and lines 36 – 41.) This Technical Subject Hierarchy is used to create a set of sophisticated expert technical searches (ETS). An expert search is created to identify patents or technical documents that are pertinent to each individual category within the Customized Technical Subject Hierarchy and the results of these searches are electronically stored in tables

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represented by Stage V in Figure 1. (See col. 5, lines 51 – 52 and 56 – 60.) Stage V represents the stored assignment of each patent to one or more of the categories in the Customized Technical Subject Hierarchy of Stage IV. By this approach, each category is populated with records that match the search criteria. The automatic execution of expert technical searches analyze the indexing, abstract, text and/or technical document to one or more categories in the Customized Technical Subject Hierarchy of Stage IV. (See col. 6, lines 5 – 13.)

The Office Action recites, and Appellant agrees, that Unger teaches the element of “determining the document category of the loaded document” at col. 3, lines 9 – 15. This passage states:

This database disaggregates a set of patents and/or technical documents into discrete technical categories by use of a set of pre-defined search protocols which match the scientific or technical concepts within the model. The pre-determined search strategies automatically categorize the set of technical documents to fit the multidimensional hierarchical model of a scientific or business discipline.

The “pre-determined search strategies” referenced in this passage are in fact the ETS discussed at col. 5 and elsewhere in the Unger disclosure. Thus, technical documents, such as patents or scientific or technical publications, or abstracts of those patents or publications, are assigned to one or more categories within the hierarchical model (col. 2, lines 61 – 65) using the ETS and resulting in “populating” the database with the categorized documents. The ETS are discussed in several places in the Unger disclosure; see, for example, col. 7, lines 26 -40, lines 47 – 51, lines 54 – 65; col. 8, lines 20 -34, and lines 51 – 62. The discussion of Example 1 in col. 7, lines 52 – 65 in particular succinctly describes “automatically assigning patents to categories.” It is important to note the role of the ETS in the Unger disclosure. In the discussion below it is shown that passages in Unger discussing the ETS are additionally cited in the Final Office Action as teaching other elements in claim 1: this provides the basis for the flawed § 102(b) rejection.

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The inevitable consequence of showing that Unger teaches the “determining” step of claim 1 with the above disclosure is that the Examiner must now show where Unger teaches the remaining required steps of claim 1, specifically the extracting and applying steps. While the language of claim 1 does not dictate a temporal order on the determining and extracting steps, the applying step must follow these two steps because the applying step uses data generated from the determining and extracting steps. Thus, the Examiner must provide a showing of teachings in Unger that disclose the applying step and all of its limitations occurring after the database in Unger is populated by the ETS.

The Unger reference does not teach or disclose the “applying” step.

The Office Action of June 9, 2005 recites (at page 3, paragraph 7) several passages in Unger to support the teaching of the first element of the applying step, “applying to said loaded document at least one document handling procedure associated with the document category of said loaded document.” The cited passages are at col. 3, lines 22 – 28; col. 4, lines 44 – 57; and col. 7, lines 40 – 46. Appellant provides the exact text of each of these passages below to specifically illustrate that Unger does not provide the requisite teaching.

Unger at col. 3, lines 22 – 28 states that “[t]he categorization may then be used by the relational database to identify trends and discontinuities in the research efforts represented by the technology in the underlying technical documents and/or patents. The categorization may also be used to allow the technical experts to chill-down [sic] and examine the underlying documents and/or abstracts and/or claims which contribute to these trends and discontinuities.” It is unclear what “document handling procedure” is taught in this passage. The second sentence relates to technical experts who are presumably human and so cannot provide a document handling procedure in the computer-implemented method of claim 1. The first sentence discusses identifying trends and discontinuities using the categorization. However, the claim language in the applying step of claim 1 says the document handling procedure is associated with the category determined in the earlier step. Appellant respectfully submits that “identifying trends and discontinuities using the categorization” does not provide the requisite teaching of applying a document handling procedure associated with the document category of said loaded document.

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Unger at col. 4, lines 44 – 57 discloses “[t]he relational database can also contain subject-specific tables of technical details such as catalyst precursors, cocatalysts, reaction conditions, reactor types, product characteristics, which are captured in a discrete form by scientists evaluating the underlying patents. The original classification serves to group similar patents together. An individual scientist or engineer may then evaluate each patent in a particular group and capture the essential details of each invention into a subject-specific table which can be linked back to the original documents and/or abstracts and to the original categorization. The expert analysis can also feed back into the categorization of the patents to enhance the categorization achievable by sophisticated technical searches.” Again, it is unclear what the “document handling procedure” taught herein is. It appears that this passage is cited for the teaching that an individual scientist or engineer is able to evaluate each patent. However, a document handling procedure performed by a human is not an appropriate teaching for an element in the computer-implemented method of claim 1.

Unger at col. 7, lines 40 – 46 discloses that “[t]he categorization may then be used to identify trends and discontinuities in the research efforts represented by the technology in the underlying technical documents and/or patents. Furthermore, mathematical relationships may be applied against the matrix of technical categories to extract hidden details and patterns and to generate additional levels of abstraction.” Again, Appellant respectfully submits that identifying trends and discontinuities using the categorization does not provide the requisite teaching of applying to the loaded document a document handling procedure associated with the document category of the loaded document. Even if the “mathematical relationships” in this passage are interpreted to be the document handling procedure, the language of claim 1 requires applying the document handling procedure to the loaded document and not “against the matrix of technical categories.”

The Office Action of June 9, 2005 recites (at page 3, paragraph 7) several passages in Unger (identified and discussed below) to support the teaching of the second element of the applying step, which further modifies the document handling procedure to require that the document handling procedure link the loaded document to at least one of the plurality of stored documents using the at least one of the document date, the document transaction

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type and the document identifier extracted from the loaded document.” Specifically, the Final Office Action recites passages in Unger at col. 4, lines 44 – 57, col. 5, lines 17 – 35, col. 6, lines 48 – 51, col. 7, lines 26 – 51 and 55 – 65, col. 8, lines 52 – 67, col. 9, lines 1 – 4 and 54 – 60, and col. 10, lines 34 – 65. Appellant provides the exact text of each of the cited passages below to specifically illustrate that Unger does not provide the requisite teaching.

Unger at col. 4, lines 44 – 57 discloses that “[t]he relational database can also contain subject-specific tables of technical details such as catalyst precursors, cocatalysts, reaction conditions, reactor types, product characteristics, which are captured in a discrete form by scientists evaluating the underlying patents. The original classification serves to group similar patents together. An individual scientist or engineer may then evaluate each patent in a particular group and capture the essential details of each invention into a subject-specific table which can be linked back to the original documents and/or abstracts and to the original categorization. The expert analysis can also feed back into the categorization of the patents to enhance the categorization achievable by sophisticated technical searches.” As noted above, the actor in this passage is not part of a computer-implemented method but is rather an individual scientist or engineer. Moreover, the passage states that the scientist or engineer who evaluates each patent captures the essential details of each invention into a subject-specific table which can be linked back to the original documents and/or abstracts and to the original categorization. In claim 1, the document handling procedure links the loaded document to one of the stored documents, not a “subject-specific table” to an original document. Further, there is no reference in this passage, nor any specific interpretation provided in the Office Action, to using the at least one of the document date, the document transaction type and the document identifier extracted from the loaded document in the extracting step in claim 1 to link the loaded document to the stored document. Apart from containing the word “link”, Appellant fails to see where this passage teaches the second element of the applying step.

Unger at col. 5, lines 17 – 35 discusses Stage III of Figure 1 which occurs prior to document categorization by the ETS. This passage recites that “[s]tage III represents the electronic capture of Patent Abstracts, and/or technical documents and the parsing of the

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complex, multi-entity data fields which usually accompany these Patent Abstracts, such as the Patent Inventors, Patent Numbers, Patent Companies (Assignees), Patent Legal Status and Patent Priority data. For example, the Parsed Patent Number Record would capture a separate record for each patent equivalent including the patent number, publication date and patent status. Similar levels of detail are captured for each parsed field. Also represented at this level is the electronic capture of the U.S. Claims and the European Claims (granted patent and published applications) and associated information such as inventor and assignee. All of these fields are electronically linked and may be electronically displayed as a set of information pertinent to one particular patent and/or patent family on a computerized graphical interface. Technical Documents may be similarly captured and the associated complex fields parsed to yield normalized data.” This passage discusses the parsing of the data items contained in each one of the technical documents before the ETS categorizes the documents. Arguably, this passage might be cited for its discussion of a “document handling procedure” that takes place before the document category is determined. However, if such an interpretation were made, it follows that it cannot teach the second element of the applying step in claim 1. Again, it appears that this passage was cited in support of this element because it contains the word “linked.”

Unger at col. 6, lines 48 – 51 discloses that “[t]he patent numbers for this set of patents may then be used as unique identifiers to electronically link to full text sources of patents and display the full text and associated graphic images of the set of patents.” Presumably, this passage is cited as teaching the “document identifier” language in the extracting and applying steps. Assume that the loaded document in claim 1 is a patent document, that an ETS has determined the category of the patent document, and that the extracting step has extracted the patent number (document identifier) from the loaded document. Then the applying step in claim 1 requires applying a document handling procedure associated with the category of the patent document, the document handling procedure linking the patent document using the patent number to one of the plurality of stored (e.g. other patent?) documents. Appellant respectfully submits that this passage does not teach that document handling procedure.

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Unger at col. 7, lines 26 – 51 disclose that “[t]he expert technical and/or scientific searches (ETS) use all the expertise of a skilled technical searcher and capture that expertise in a set of pre-defined search strategies. These pre-defined search strategies may be run against one or more sets of technical documents, such as patents assigned to a particular business or scientific entity or in a particular technical specialty. The pre-defined search strategies automatically categorize the set of technical documents to fit the multidimensional hierarchical model of a scientific or business discipline. The pre-defined search strategies may be conducted on a commercial database system and the results stored in a local electronic database or the pre-defined search strategies may be stored and executed in a local electronic database containing records captured from a commercial database system. The categorization may then be used to identify trends and discontinuities in the research efforts represented by the technology in the underlying technical documents and/or patents. Furthermore, mathematical relationships may be applied against the matrix of technical categories to extract hidden details and patterns and to generate additional levels of abstraction.” As already noted above, the portion of this passage that discusses the ETS (from lines 26 – 40) support the step of determining the document category and have no relevance to teaching the applying step. Lines 40 – 51 disclosing the identification of trends and discontinuities were discussed above because this passage was cited for teaching the first element of the applying step. Appellants fail to see where any text in this passage could be interpreted to teach the document handling procedure linking the loaded document to at least one of the plurality of stored documents using the at least one of the document date, the document transaction type and the document identifier extracted from the loaded document.

Unger at col. 7, lines 55 – 65 discloses Example 1 entitled “Automatically Assigning Patents to Categories within a Hierarchical Model of a Business or Technical Specialty.” Example 1 shows the logic for automatically assigning patents to a pre-defined subject-specific-hierarchy, using a series of expert technical searches (ETS). Example 1 reads as follows: “Create a Subject Hierarchy which models a complex business or technical entity. For each Subject in the Hierarchy, create an expert technical search (ETS), apply the expert technical search against a set of patent data, for each patent which

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matches the expert technical search (ETS) criteria create a record in a table indicating the subject and the patent's unique identifier." As already noted above, this description is what Unger discloses as the step of determining the category of the loaded document. The Examiner is apparently making the argument that this passage simultaneously supports the element of determining the document category of the loaded document and also supports the element of applying to the loaded document a document handling procedure associated with the document category. The language of the applying step in claim 1 states that the document handling procedure applied to the loaded document is associated with the document category. In Unger, the language "create a record in a table indicating the subject and the patent's unique identifier" is done for every document, regardless of category, in order to populate the data base. For this passage to be relevant, it must further include language to indicate applying some further document handling procedure to the loaded patent document effect that based on the patent's subject (category). The cited passage does not do that.

Unger at col. 8, lines 52 – 67 discloses that more about the ETS. This passage states that "[t]he expert subject searches in Example 3 would be further modified and customized to fit the particular needs of a specific hierarchical model. For example, the overall database might be focused on oil well drilling additives or it might be focused on cosmetic formulations. The searches would be further refined to selectively retrieve one set of patents or technical documents for a database focused on fluid loss control additives, for use in oil well drilling fluid additives, and to selectively retrieve a different set of patents or technical documents for a database focused on cosmetic formulations." Again, as already noted several times, this is a discussion of the ETS which has been cited for supporting the element of determining the document category. This passage cannot also teach the applying step of claim 1.

Unger at col. 8, lines 65 – 67 to col. 9, lines 1 – 4 discloses that "[i]n the preceding steps, each patent has been automatically assigned to one or more categories within the Subject-Specific-Hierarchy and linked to the parent patent record in the relational database. Also in preceding steps, the complex, multi-entity data fields have been parsed to multi-field tables and linked to the parent patent or technical document record in the relational

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database.” Appellant respectfully submits that these sentences refer to applying the ETS to the patent documents that have been evaluated by the individual scientists and engineers, as taught in Unger at col. 5, lines 17 – 35 in the discussion of Stage III of Figure 1. Again this passage talks about linking data in tables to patent documents, and does not teach applying a document handling procedure associated with the document category to link the loaded document to one of the stored documents using at least one of using the at least one of the document date, the document transaction type and the document identifier extracted from the loaded document.

Unger at col. 9, lines 54 – 60 appears to refer back to a graphical display of data from the relational data base created in Unger as shown in Figure 2. (See col. 9, lines 16 – 19.) The cited passage states “[t]here is no limit to the number of dimensions which can be displayed in this fashion. More complex tabular displays and graphical displays may be created by linking the category populations (i.e. the count of patents assigned to each category) to the multi-entity data fields (e.g. patent number, patent status, patent publication date, company data, inventor data) and creating multidimensional tabular and graphical displays.” Again, it appears that this passage has been selected because it contains the word “linking” without regard to the specific function being performed. What is being “linked” in this passage are category populations to multi-entity data fields. In the applying step in claim 1, the document handling procedure associated with the document category links the loaded document to at least one of the plurality of stored documents using at least one of the document date, the document transaction type and the document identifier extracted from the loaded document.

Unger at col. 10, lines 34 – 65 is a lengthy passage, not quoted in its entirety here, that discusses how higher level concepts about the data stored in the data base may be obtained. The beginning of this passage discloses that “[t]his invention further includes the method of deriving more abstract concepts from the set of stored category), assignments, by applying mathematical methods to extract these more abstract concepts. These more abstract concepts can not be readily identified by the application of expert technical searches alone. However, a method of quantifying the research effort expended in the areas defined by each of these more abstract concepts is of great value. ... The present

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database includes a multidimensional hierarchy of subject categories wherein the different levels of the hierarchy are interrelated by a mathematical formula. The mathematical formula which interrelates the different levels takes the form of a sum of an aggregate count of unique items in a category multiplied by weighting factors for each category in the next higher (more abstract) level. Each higher (more abstract) level of the hierarchy is therefore a weighted sum of contributions from each category in the previous level.” The Final Office Action provides no specific interpretation of how this passage teaches the elements of the applying step of claim 1. It would seem clear, however, that this discussion of how to obtain high level abstract concepts from the data base deals with handling the data in the data base at an aggregate level, and not at the individual document level. This passage does not appear to concern itself with the linking of the loaded document with one of the plurality of stored documents.

In summary, Appellant respectfully submits that none of the passages cited in Unger for teaching the applying step of claim 1 actually provides such a teaching. The Unger reference simply does not anticipate claim 1, and the Final Office Action fails to state a prima facie case of anticipation under 35 U.S.C. § 102(b). Appellant respectfully requests that this rejection be withdrawn as to independent claims 1, 3 and 5.

II. The Final Office Action fails to state a prima facie case of obviousness under 35 U.S.C. § 103(a) with respect to claims 7, 11, 14 and 17.

The Final Office Action rejected claims 7, 11, 14 and 17 under 35 U.S.C. § 103(a) as being unpatentable over the disclosure of U.S. Patent 5,721,910 issued to Unger et al., in view of Official Notice.

Unger does not teach or disclose the elements of Claim 7.

With respect to claim 7, the Final Office Action recites the same passages in Unger as teaching each and every claim limitation of claim 7, noting that Unger does not teach the transfer of computer-executable instructions from one or more first computers to a second computer. The Final Office action takes Official Notice that both the concept and advantage of transferring computer-executable instructions from one computer to another

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is well known in the art. Appellant appeals the rejection of claim 7 for the same reasons noted above with respect to claims 1, 3 and 5: Unger does not teach the applying element of claim 7. Appellant respectfully requests that the rejection of Claim 7 be withdrawn.

Claims 11, 14 and 17.

Claims 11, 14 and 17 recite the limitation that the document category is determined by a pre-determined category input with the loaded document. The Final Office action takes Official Notice that it would have been obvious to manually assign the document category when loading the document. Appellant respectfully submits that Unger teaches away from the manual assignment of the document category to the document by the use of the expert technical searches which automatically categorize the documents in the database taught in Unger. The Final Office Action fails to state the motivation or suggestion for altering the process in Unger from automatically categorizing the documents using the expert technical searches to manually assigning a category to each document. To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See, e.g., In re Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002) ("When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.") Clearly, regardless of whether a person of ordinary skill in the art would recognize that the document category could be pre-determined manually, the Final Office Action fails to state the motivation for modifying the categorization process in Unger to do so.

III. The Final Office Action fails to state a prima facie case of obviousness under 35 U.S.C. § 103(a) with respect to claims 2, 4 and 6.

The Final Office Action rejected claims 2, 4 and 6 under 35 U.S.C. § 103(a) as being unpatentable over the disclosure of U.S. Patent 5,721,910 issued to Unger et al., in view of the disclosure of U.S. Patent 5,071,419 issued to MacPhail (hereafter "MacPhail.")

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MacPhail is cited for teaching that the processing rule includes retention criteria for determining how long to save a document. The Office Action states, as motivation for the combination of Unger and MacPhail, that “MacPhail’s teaching of using retention criteria to determine whether the documents in the document storage exceeds expiration date can help the processing rule in Unger’s system to automatically delete documents that are no longer needed to save system storing space.”

First, since claims 2, 4, 6, and 8 depend on and further limit claims 1, 3, 5, and 7, these dependent claims are patentable for the same reasons cited above for the patentability of claims 1, 3, 5 and 7 over the Unger reference.

Moreover, claims 2, 4, 6, and 8 are also patentable over the combination of Unger and MacPhail because Unger appears to teach away from establishing any sort of retention scheme for the records in the technical database. See for example col. 6, lines 24 – 33 where Unger states:

The database system allows patents and/or technical documents to be electronically captured and analyzed at a convenient time. This set of analyzed patents and/or technical documents may then be used to identify trends and discontinuities in the overall pattern of research efforts represented by the set of patents or technical documents. These trends and discontinuities may be identified any time following the analysis of the set of patents and/or technical documents. The stored analysis may be used minutes, days, months or years later.

As already noted above, the database records in the Unger database are specifically included and categorized for the purpose of building a multidimensional hierarchical model which reflects the business, scientific or technical interests of a business, scientific or technical entity or specialty. (Abstract). “In order to create a computer system which can answer higher level questions such as these, the computer system must have a pre-defined model of the overall scientific or business discipline and the computer system must have already analyzed the technical content of each patent or technical document with respect to that model.” (Col. 4, lines 32 – 37.). Unger clearly suggests that these

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documents are included or not included in the database based on the initial model, and not based on some retention scheme. If the analysis that can be generated can be used “minutes later” or “years later,” then clearly it is the model that controls retention of the individual technical documents in the database.

MacPhail teaches a method for managing the automatic retention and deletion of a relatively large number of documents that are stored in the system by a plurality of end users. (Abstract). The method establishes a dual label for each document that is to be stored in the system. The first label is the Document Label (DL) and functions to identify the business use classification of the document. The second label is the Ownership Label (OL) and functions to identify a document classification assigned by the owner which in most situations is the author. See col. 3, lines 10 – 16. Ownership implies the authority and responsibility for the document during the ownership period. Col. 3, lines 21 – 23. Each document filed in the system has associated with it the label and expiration date criteria that are employed to automatically manage the retention and deletion of documents from the system. Col. 3, lines 26 – 29. There are also system default expiration dates that are entered for documents when no dates are entered by a user who processes a document. See col. 3, lines 44 – 58.

It is respectfully submitted that the database of documents in Unger is not suitable for the retention method disclosed in MacPhail. As noted above, the categories defined in the model seem to control which documents are included or retained in the database. Moreover, if there are several users of the Unger database, it would seem unreasonable to allow any one user control over when to delete a document, since deleting a document from a category will affect the accuracy of the analysis of technical trends and discontinuities for that category for other users of the database.

The Office Action mailed June 9, 2005 discusses Applicant's argument with respect to the MacPhail reference at pages 9 -10 and seems to have misunderstood Applicant's argument. Nothing in Applicant's argument suggests that Applicant believes that the MacPhail reference is “nonanalogous art.” The June 9, 2005 Office Actions states at page 10 that “only administrator or the user who file the document to the system can set

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to time to retain the document and that the document that expires the time of retention is deleted when it is not needed, not by the control of other users.” Applicant argues that this is precisely what is implausible about the MacPhail retention scheme as applied to the Unger database disclosure: The documents in the Unger system are not filed in the data base by individual users; the database is populated with documents through use of the ETS. Applying the retention scheme in MacPhail to the data base in Unger would allow a user who did not necessarily store a technical document in the data base to establish a retention scheme for the technical document to the detriment of other users.

For the foregoing reasons, it is respectfully submitted that a person of ordinary skill in the art would not look to the MacPhail reference to develop a retention scheme for the technical documents in the database taught in Unger. The motivation to make the combination cited in the Office Action is simply not reasonable.

IV. The Final Office Action fails to state a prima facie case of obviousness under 35 U.S.C. § 103(a) with respect to claims 12, 15 and 18.

The Final Office Action rejected claims 12, 15 and 18 under 35 U.S.C. § 103(a) as being unpatentable over the disclosure of U.S. Patent 5,721,910 issued to Unger et al., in view of the disclosure of U.S. Patent 6,418,457 issued to Schmidt et al. (hereafter “Schmidt.”)

Claims 12, 15 and 18 further modify the information extracted from the loaded document and the function of the document handling procedure. In these claims the information extracted from the loaded document is a document identifier indicating an account number and a transaction date. With this information, the document handling procedure links the loaded document to a set of stored documents having the account number; the document handling procedure further orders the loaded document among the set of stored documents by the transaction date.

The Final Office Action states, at page 8, that Unger does not teach the limitations of claims 12, 15 and 18. The Final Office Action cites the Schmidt reference for this teaching. Schmidt discloses a computerized document storage system for use by inventors to store their work on an invention and to secure their claim to a date of invention.

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(Abstract.) The disclosure discusses a notebook database which is an electronic replacement for the traditional inventor's notebook. Col. 3, lines 35 – 36. A second database, the patent database, makes the electronic documents that proceed on to become patent applications accessible to a larger population within the business. Col. 5, lines 9 – 15. The patent database provides a company-wide archive of all documentation associated with each disclosure made by the company, and provides electronic search and retrieval of data by various means. See col. 6, lines 39 – 44.

The Final Office Action recites the passages in Schmidt at col. 5, lines 23 – 37, 41 – 43, 55 – 56 and 65 – 67 and at col. 6, lines 1 – 27, 33 – 38, 43 – 48 and 54 – 65 as teaching the claim limitations of claims 12, 15 and 18. It would appear that the document identifier indicating an account number is the sequential number assigned to a disclosure initially released to a patent attorney in Schmidt at col. 5, lines 23 – 27. The data base provides a date sort feature which places the disclosure number groups in the order of when the disclosure is sent to the attorney. Col. 5, lines 55 – 56.

The Final Office Action states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Unger and Schmidt because Schmidt's teaching of providing documents related to the loaded document using the identifier of the loaded document enables Unger's method to bring up the full history of the loaded document including previous revisions, citing the passages in Schmidt from col. 5, lines 65 – 67 to col. 6, lines 1 – 27.

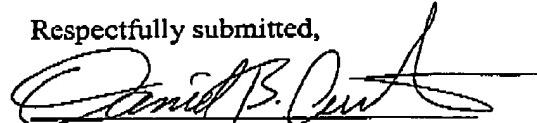
Appellant respectfully submits that the documents in the database taught in Unger are not suitable for the document handling methods disclosed in Schmidt. The documents in Unger are published technical documents whose content is fixed. Data items are mined or extracted from the documents for purposes of doing data analysis but the Examiner points to no teaching in Unger that indicates that the documents themselves undergo revisions or have versions for which a history is needed. It is respectfully submitted, therefore, that a person of ordinary skill in the art would have no motivation to modify the data base in Unger with the teachings of Schmidt to provide for a document history for the technical documents accommodated in the Unger database. Claims 12, 15 and 18 provide for linking the loaded document to other stored documents having the same account

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number and storing the loaded document in transaction date order. While this is a useful feature in the document database taught in Schmidt, there is little evidence that such a feature is useful in the database taught in Unger.

In view of the discussion and arguments presented above, Appellant respectfully submits that claims 1 – 18 are patentably distinguishable over the references cited in the rejections in the Final Office Action, and are in condition for allowance. Appellant requests that the rejections to claims 1 – 18 be withdrawn and the application be passed to issue.

Respectfully submitted,



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CLAIMS APPENDIX

- 1 Claim 1: A computer-implemented method for adding a document to a plurality of
2 stored documents, comprising:
3 loading the document into storage, said loaded document having a document
4 category;
5 determining the document category of said loaded document;
6 extracting information from said loaded document indicating at least one of a
7 document date, a document transaction type and a document identifier; and
8 applying to said loaded document at least one document handling procedure
9 associated with the document category of said loaded document; said document handling
10 procedure linking said loaded document to at least one of said plurality of stored
11 documents using the at least one of the document date, the document transaction type and
12 the document identifier extracted from said loaded document.
- 1 Claim 2: The computer-implemented method of claim 1, wherein the document handling
2 procedure includes retention criteria for determining how long to save the loaded
3 document.
- 1 Claim 3: A computer system having a processor, a display and memory, the memory
2 including an operating environment, and a computer-readable medium having computer-
3 executable instructions for performing a method for adding a document to a plurality of
4 stored documents, comprising:
5 computer-executable instructions for loading a document into storage, said loaded
6 document having a category;

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7 computer-executable instructions for determining the document category of the
8 loaded document;
9 computer-executable instructions for extracting information from said loaded
10 document indicating at least one of a document date, a document transaction type and a
11 document identifier; and
12 computer-executable instructions for applying to the loaded document a document
13 handling procedure associated with the document category, said document handling
14 procedure linking said loaded document to at least one other of said plurality of stored
15 documents using the at least one of the document date, the document transaction type and
16 the document identifier extracted from said loaded document.

1 Claim 4: The computer system of claim 3, wherein the document handling procedure
2 includes retention criteria for determining how long to save the loaded document.

1 Claim 5: A computer program product having a computer-readable medium holding
2 computer-executable instructions for performing a method for adding a document to a
3 plurality of stored documents, the method comprising:
4 loading the document into storage, said loaded document having a document
5 category;
6 determining the document category of said loaded document;
7 extracting information from said loaded document indicating at least one of a
8 document date, a document transaction type and a document identifier; and
9 applying to said loaded document a document handling procedure associated with
10 the document category of said loaded document, said document handling procedure linking

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11 said loaded document to at least one of said plurality of stored documents using the at
12 least one of the document date, the document transaction type and the document identifier
13 extracted from said loaded document.

1 Claim 6: The computer program product of claim 5, wherein the document handling
2 procedure includes retention criteria for determining how long to save the loaded
3 document.

1 Claim 7: A method for transferring a computer program product from one or more
2 first computers to a second computer connected to the one or more first computers through
3 a communications medium, comprising:

4 (a) accessing, on the one or more first computers, computer-executable instructions
5 for adding a document to a plurality of stored document; the computer-executable
6 instructions when executed by a computer, performing the steps of:

7 (1) loading the document into storage, said loaded document having a
8 document category;

9 (2) determining the document category of the loaded document;

10 (3) extracting information from said loaded document indicating at least one
11 of a document date, a document transaction type and a document identifier; and

12 (4) applying to the loaded document a document handling procedure
13 associated with the document category, said document handling procedure linking
14 said loaded document to at least one other of said plurality of personal documents
15 using the at least one of the document date, the document transaction type and the
16 document identifier extracted from said loaded document; and

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17 (b) transferring the computer-executable instructions from the one or more first
18 computers to the second computer through the communications medium.

1 Claim 8: The method of claim 7, wherein the document handling procedure includes
2 retention criteria for determining how long to save the loaded document.

3 Claim 9: The computer-implemented method of claim 1 wherein the loaded document
4 further includes document format data specifying whether the loaded document is an
5 electronic document or a document image.

1 Claim 10: The computer-implemented method of claim 1 wherein the document category
2 of the loaded document is determined by data content extracted from the loaded document
3 and matched to a pre-determined set of document categories.

1 Claim 11: The computer-implemented method of claim 1 wherein the document category
2 is determined by a pre-determined category input with the loaded document.

1 Claim 12: The computer-implemented method of claim 1 wherein the information
2 extracted from the loaded document is a document identifier indicating an account number
3 and a transaction date; and wherein the document handling procedure links the loaded
4 document to a set of stored documents having the account number; the document handling
5 procedure further ordering the loaded document among the set of stored documents by the
6 transaction date.

1 Claim 13: The computer system of claim 3 wherein the document category of the loaded
2 document is determined by data content extracted from the loaded document and matched
3 to a pre-determined set of document categories.

1 Claim 14: The computer system of claim 3 wherein the document category is determined
2 by a pre-determined category input with the loaded document.

1 Claim 15: The computer system of claim 3 wherein the information extracted from the
2 loaded document is a document identifier indicating an account number and a transaction
3 date; and wherein the document handling procedure links the loaded document to a set of
4 stored documents having the account number; the document handling procedure further
5 ordering the loaded document among the set of stored documents by the transaction date.

6 Claim 16: The computer program product of claim 5 wherein the document category of
7 the loaded document is determined by data content extracted from the loaded document
8 and matched to a pre-determined set of document categories.

1 Claim 17: The computer program product of claim 5 wherein the document category is
2 determined by a pre-determined category input with the loaded document.

1 Claim 18: The computer program product of claim 5 wherein the information extracted
2 from the loaded document is a document identifier indicating an account number and a
3 transaction date; and wherein the document handling procedure links the loaded document
4 to a set of stored documents having the account number; the document handling procedure
5 further ordering the loaded document among the set of stored documents by the transaction
6 date.

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EVIDENCE APPENDIX

None.

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RELATED PROCEEDINGS APPENDIX

None.